

REMARKS

Oath/Declaration

The Examiner has alleged that the present oath or declaration is defective. Specifically, the Examiner has alleged that the originally executed oath or declaration is defective because, while the present application purports to claim priority to USSN 60/135,736, the inventors of that application are not the same as those of the present application.

In response, Applicants respectfully submit that the present application also claims priority to USSN 60/123,090, and that the combined inventive entity of USSN 60/135,736 and USSN 60/123,090 is identical.

Priority

A paragraph has been added to the specification describing the priority information. The Examiner has also indicated that if the application is a national stage application based on an international application filed on or after November 29, 2000, the specific reference to the priority information must be submitted during the pendency of the application and within the later of four months from the date on which the national stage application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. § 371(b) or (f) or sixteen months from the filing date of the prior application.

Applicants respectfully submit that since the present application is a national stage application based on an international application filed March 2, 2000 [with a 102(e) date of June 16, 2000], correction of the priority information at the present time without a petition to do so is proper.

In any event, Applicants do not believe that a formal correction of the priority is even necessary in that the omission of the priority claim to USSN 60/123,090 was the result of PTO error. Applicants also enclose a photocopy of the filing receipt received by Applicants on Feb.

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Patent Docket **P1548R1**

Amend. dated: August 17, 2004

Response to Office Action mailed on: April 20, 2004

19, 2002 clearly indicating the priority claim of the present application to both USSN 60/123,090 and USSN 60/135,736.

Judicially Created Double Patenting Rejection

The Examiner has alleged that Claims 18, 19, 22, 23 and 25-27 of this application conflict with claims 78-84 of co-owned Application No. 10/121,045 (Publication No. 20030073210).

In response, Applicant respectfully submit that the cancellation of the conflicting claims 78-84 in the co-owned application has rendered the rejection moot.

Rejection Under 35 U.S.C. § 102(a) (cited references)

Claims 1-3, 5, 6, 11-19, 22, 23, 25-27 are rejected under 35 U.S.C. § 102(f) because the Applicants did not allegedly invent the claimed subject matter. Specifically, the Examiner alleges that the present application contains a priority claim to USSN 60/135,736, which had a different inventive entity from the present application.

In response, Applicant respectfully submit that the Application also claims priority to USSN 60/123,090, filed March 5, 1999. The combined inventive entity of USSN 60/135,736 and USSN 60/123,090 are identical to the inventive entity of the present application.

Applicants respectfully request reconsideration and withdrawal of the rejection of Claims 1-3, 5, 6, 11-19, 22, 23, 25-27 are rejected under 35 U.S.C. § 102(f).

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SUMMARY

Claims 1-3, 5, 6, 11-19, 22, 23, 25-27 are pending in the application.


If in the opinion of the Examiner, a **telephone conference** would expedite the prosecution of the subject application, the Examiner is **strongly encouraged** to call the undersigned at the number indicated below.

This response/amendment is submitted with a transmittal letter and petition for a 1-month extension of time and fees. In the unlikely event that this document is separated from the transmittal letter or if fees are required, applicants petition the Commissioner to authorize charging our Deposit Account 07-0630 for any fees required or credits due and any extensions of time necessary to maintain the pendency of this application.

Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,
GENENTECH, INC.

Date: August 17, 2004
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By: 

Craig G. Svoboda
Reg. No. 39,044
Telephone No. (650) 225-1489